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| 10/009,932      | 05/24/2002  | John S. Ramey        | 7536.106            | 6716             |

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EXAMINER

DEMILLE, DANTON D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3764

DATE MAILED: 04/22/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/009,932

Applicant(s)

RAMEY ET AL.

Examiner

Danton DeMille

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All · b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

*Specification*

The amendment filed 11 December 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: applicant appears to be claiming a combination of a dermal abrasion device and massage apparatus in the same embodiment however, there is no such combination disclosed. Applicant has disclosed a massaging apparatus in figures 1-7 and a dermal abrasion device in figures 8-12B but not the combination of an abrasion device having a head that defines a cavity and a post within the cavity as claimed nor would it appear to be possible from the disclosure. There is also no disclosure for "means for moving the area of negative pressure along the surface of the patient" as claimed. The device includes a hand piece for moving the device by hand. There is no structure or "means" disclosed capable of performing this function.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

**Claims 23-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not adequately described as set forth in the above objection to the specification.**

***Claim Rejections - 35 USC § 112***

**Claims 23-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

It is not clear how to interpret claims to an abrasion device in combination with a massage head such as that having a head that defines a cavity with a post within the cavity for massaging since nothing like that is disclosed.

The claims also recite “means for moving the area of negative pressure along the surface of the patient”. There is no support in the disclosure for a structure to move the hand piece over the patient.

In claims 24, 42, it is recited that the means for generating the area of negative pressure comprises the vacuum generator. The vacuum generator is recited as that which generates a vacuum. That would appear to be the vacuum source 48. The vacuum source 48 is not part of the hand piece. Applicant has already recited a means for generating an area of negative pressure. It is not clear how the means for generating the negative pressure further comprises a vacuum generator. If anything they are the same thing. How is the means for generating negative pressure further defined by the vacuum generator?

Regarding claim 37, there is no antecedent basis for “the lofting chamber”.

Regarding claim 60, there is no clear antecedent basis for "the feeding chamber".

Regarding claim 61, there is no clear antecedent basis for "the receiving channel" and "the feeding chamber".

Regarding claim 62, there is no clear antecedent basis for "the feeding chamber".

Regarding claim 63, there is no clear antecedent basis for "the dermabrasive supply device".

Regarding claim 64, there is no clear antecedent basis for "the delivery channel".

Regarding claim 65, there is no clear antecedent basis for "the material retrieval holding device".

Regarding claim 72, there is no clear antecedent basis for "the sin surface".

To any extent the claims are understood and appear to be supported by a clear and complete disclosure, the following appears to be appropriate.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 23, 24, 30-32, 42, 59 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rosso 5,207,234.**

Rosso teaches a delivering and retrieving material means including a hand piece 2 with an outlet passage 6 for generating an area of negative pressure and the rim around the aperture forming the front wall 3 would appear to be a means for applying positive pressure. The abrasive handling device includes an abrasive supply device, a receiving channel 18, a feeding

chamber, 17, a delivery channel 7 and a waste retrieval holding device 10. To any extent applicant's abrasion apparatus of figure 12A also massages so does the Rosso device.

Regarding claim 32, Rosso teaches an interchangeable head 2 column 1, lines 65-66.

**Claims 43-51, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tasedan 4,333,277.**

Tasedan figure 2 shows all of the elements claimed. An intake aperture is located in the intake channel 34 where channel 32 connects. The retrieval channel 50 includes an outlet aperture at 22. The outlet aperture 22 is offset from the intake aperture 42.

Regarding claims 48, 50, Tasedan teaches a middle portion where the grip handle 26 is and an end portion 58 that are removably connected.

Regarding claim 51, Tasedan teaches a clamp 64 that would be in the shape of an O-ring and would appear to comprehend the claim language.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 25-28, 60-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosso 5,207,234 in view of Mehta 3,543,444.**

Rosso fails to teach a continuous supply of abrasive material within chamber 17. The chamber 17 would have to be continuously refilled. Mehta teaches a container for abrasive

material that has a continuous supply by gravity feed from overhead source 57, 54, 39. It would have been obvious to one of ordinary skill in the art to modify Rosso to provide a gravity feed supply as taught by Mehta so that one doesn't have to shut the system down to refill the chamber 17.

Regarding claim 27, Mehta teaches a plurality of feeding chambers 54, 39 in the top part of the lower feeding chamber 1. The upper feeding chambers have generally inwardly sloped walls. It would have been obvious to one of ordinary skill in the art to modify Rosso to include the continuous feeding chambers as taught by Mehta including the generally sloping sides to provide a continuous gravity feed supply so that one doesn't have to shut the system down to refill the chamber 17.

**Claims 29, 33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosso 5,207,234 in view of Parker 554,299.**

The delivery channel 18 of Rosso opens in the top portion of the chamber 17 just as Parker's delivery channel G opens in the top portion of the chamber A. The shape of the delivery channel is an inverted generally funnel-shaped collector. It would have been obvious to one of ordinary skill in the art to modify Rosso to have the delivery channel open in the top portion of the chamber in the shape of an inverted generally funnel-shaped collector as taught by Parker to better collect the abrasion material in the delivery channel.

Regarding claim 33, Parker teaches a feeding chamber C, a receiving channel b, D that limits the amount of abrasive, a delivery channel g placed above the feeding chamber and an intake aperture c' at the base of the feeding chamber. Rosso also teaches the same relationship of the intake aperture 19 at the base of the feeding chamber 17 with the delivery channel placed

above the feeding chamber. The only difference is Parker provide a continuous supply of abrasive. It would have been obvious to one of ordinary skill in the art to modify Rosso to have a continuous supply of abrasive including a funnel-shaped feeding chamber with a receiving channel that limits the amount of abrasive supplied to the feeding chamber as taught by Parker so as to provide a continuous feed of abrasive so that one doesn't have to shut the system down to refill the chamber.

Regarding claim 39, Parker teaches an airflow regulator in pipe L. Such would have been an obvious provision in order to regulate the air-supply to regulate the abrasion operation.

**Claims 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosso 5,207,234.**

While Rosso appears silent with regard to whether or not one can empty the contents of the canister such is well known to the artisan of ordinary skill. Eventually the canister will become filled and the ability to empty it by removing the canister to dump it is not an inventive step. It would have been obvious to one of ordinary skill in the art to modify Rosso to be able to remove the canister in the waste can receiver to be able to empty it. The filter 12 would clearly have a frame to keep it's shape spaced from the aperture 11 and likewise would be removable when the filter becomes clogged over time.

**Claims 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molinari 5,037,432 in view of Spagnolo 2,238,541.**

Molinari teaches in column 4, lines 37-41 that the device produced a massage. The amount of pressure applied during use would produce different massaging effects. There appears



to be no unobviousness to modify Molinari to vary the pressure applied to the device during use to create a deeper massage as taught by Spagnolo with abrasive pressure members 19.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).


A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 23-73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,582,442.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to rearrange the elements in other combinations. All of the limitations are recited only the arrangement of them is different.

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